

Comments of Time Warner Inc.

Re: Trademark Clearinghouse

<http://www.icann.org/en/public-comment/#tmc>

April 1, 2010

Time Warner Inc. (Time Warner) appreciates this opportunity to comment on the revised proposal for a Trademark Clearinghouse (TMC) as a feature of the rollout of new generic Top Level Domains (gTLDs).

Time Warner commends ICANN for its agreement with the concept that use of the TMC should be a mandatory element of pre-launch Rights Protection Mechanisms (RPMs) employed by all new gTLD registries. Such a requirement, if broadly applied, has the potential to improve significantly the protections afforded to consumers against the risk that the new gTLDs will attract domain name registrations that are confusingly similar to the well-established brands of Time Warner and other companies. This in turn could reduce the need for brand owners to make and maintain large numbers of costly and unproductive defensive registrations in the new gTLDs.

Unfortunately, the TMC proposal put forward by ICANN staff is too narrow to have any realistic hope of achieving this potential. Time Warner urges ICANN to re-examine its proposal in a number of areas before finalizing this aspect of the Draft Applicant Guidebook for new gTLDs. Changes are needed in which trademarks can be included in the TMC; in how new gTLD operators are required to use the TMC in their registry operations; and in how the TMC is paid for. In particular:

- All trademark registrations of national or multinational effect must not only be eligible for inclusion in the TMC, but must be capable of serving as the basis for an RPM (such as a sunrise or trademark claims service), subject to notice, disclosure and challenge procedures to combat abuse. Drawing a distinction between registered marks that have received “substantive review” of trademark applications, and those that have not, is untenable, whether that dividing line is drawn by the TMC itself or some other party, and whether or not any incapacity for a mark issued without “substantive review” can be cured by a subsequent TMC validation procedure, as proposed by ICANN.
- The range of claims that rights holders are allowed to register in the TMC must be expanded beyond exact matches with a registered word mark, to include a defined range of typographical variations (e.g. two or fewer character variations) of a protected mark, and character strings in which a protected mark is combined with any of a defined set of generic/descriptive terms. These categories beyond exact matches – for example, SUPPERMAN.kids, or HBOFILM.movie -- describe the great majority of abusive registrations that Time Warner has encountered with respect to its marks in the existing gTLDs. A database that excludes them is unlikely to provide any meaningful protections or to substantially reduce pressure for defensive registrations in the new gTLDs, the ostensible (and essential) goals of the TMC.

- To derive maximum value from the considerable effort required to compile and maintain the TMC, new gTLD registries should be required to employ it, not only for pre-launch RPMs, but also for mechanisms to discourage abusive registrations after launch, such as claims services that advise would-be registrants that their applications for registration are identical or substantially similar to trademarks listed in the TMC. Otherwise, the locus for abusive registration will simply be displaced until after the new registry formally launches, and the need for defensive registrations will scarcely diminish.
- Similarly, incentives should be provided to build the TMC database into other RPMs that registries choose to provide; and complainants in the Uniform Rapid Suspension (URS) procedure should also be able to rely on their TMC registrations to initiate cases, so that these RPMs remain cheap and streamlined.
- Expanding the reach and utility of the TMC, as outlined above, will increase its value to registrants, registries, right holders, and the public, and thus justify its costs. Since an effective clearinghouse would be an indispensable feature of any successful new gTLD launch, its costs should not be borne by trademark holders alone, but shared by ICANN, or indirectly by the new gTLD registries, and their registrars, as a cost of doing business. We remain concerned about whether trademark owners will be required to shoulder a disproportionate share of the costs of establishing and operating the TMC, especially considering the limited benefits that the TMC would deliver in its current form.

Time Warner urges that these improvements to the TMC be included in the final version of the Draft Applicant Guidebook. If you have questions, please do not hesitate to contact the undersigned.

Respectfully submitted,

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